



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,700	04/19/1999	NORIKO MIZOBUCHI	20-4518P	1380
2292	7590	12/11/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/242,700

Applicant(s)

MIZOBUCHI ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Applicant argues that under 371 application rules, the examiner has improperly restricted the claims.

The examiner notes that instant application is a 371 and notes the 371 rules. However, once the applicant receives an action on one invention, the applicant cannot change the invention mid-prosecution. Note MPEP 1893.03 wherein before any action on the merits have been made, the unity of invention rule applies. The examiner points out that the applicant has received an action on March 7, 2003 on the merits for the originally presented invention (an ointment), this invention has been constructively elected by original presentation for prosecution on the merits. However, after receiving the non-final dated March 7, 2003, applicant submitted new claims drawn to a method of treating neuralgia and a method of treating a malady, which is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons.

Accordingly, claims 27-27 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant argues that the specific range of 25-30% can be found by combining the range of 0.001-30% and 0.01-20%.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points out that nowhere in the application does not the specific range of 25-30% find support that applicant had this specific range in mind at the time of filing. The examiner notes the lower limit of 25% and finds support for this lower limit; however the range between 25-30% is not found. Further, not only as applicant amended the

Art Unit: 1616

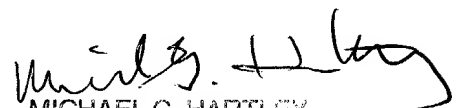
percent weight range, the applicant has amended the percent weight range in accordance to the carrier. This stipulation "wherein when the base is hydrocarbon gel or a mixture hydrocarbon range of 20 to 30% by weight per total weight, and wherein when the gel and petrolatum, the acetyl salicylic acid is in a base is petrolatum, the acetyl salicylic acid is 25 to 30% by weight per total weight" has not support in the application.

Therefore, the new matter rejections are maintained.

Applicant argues that Burton does not teach the instant weight range and that the comparative example with just aspirin demonstrates the disadvantages of not including the steroid into the composition.

Applicant's arguments are persuasive and the rejection over Burton is withdrawn. However, the application is not in condition based on the 112 new matter rejection.

~~112~~


MICHAEL G. HARTLEY
PRIMARY EXAMINER